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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,335	08/21/2003	Masakazu Takeuchi	2003946-0055 (Rabconnecti	7601
7590	07/29/2005		EXAMINER	
Patent Department Attn Charles E Lyon Choate Hall & Stewart Exchange Place Boston, MA 02109			ROOKE, AGNES BEATA	
			ART UNIT	PAPER NUMBER
			1653	

DATE MAILED: 07/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/645,335

Applicant(s)

TAKEUCHI ET AL.

Examiner

Agnes B. Rooke

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 1, 2, 9-24 and 28-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-8 and 25-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/22/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is in response to the Applicant's election without traverse of Group II, Claims 3-8 and 25-27, filed on 05/18/2005. The amendments to the claims are acknowledged.

Claims 1-31 are pending.

Claims 3-8 and 25-27 are currently under examination.

Claims 1, 2, 9-24, and 28-31 are withdrawn.

The restriction requirement is still deemed proper and is therefore made final.

A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP, paragraph 821.01.

The priority is given to JAPAN 2002-3195212, filed on 11/01/2002.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 3-6 and 25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed polynucleotide or the protein must be isolated or purified.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 3-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 3 (b), the structure of a protein is unknown, since several amino acids can be deleted, replaced or added, thus rendering the structure indefinite. Further, it is not clear what number is meant by "several."

In Claim 6 (b), the "homology" term is not correct because the similarity between two nucleotides should be claimed in terms of percent identity, for example, a statement stating: a polynucleotide sequence that has 80% identity to the SEQ ID NO:1 would be proper.

Claim 5 refers to hybridization conditions, and on page 22 of the specification, the conditions are only exemplary.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 3, 7, 8, and 25-27 are rejected under 35 U.S.C. 102(e) as being anticipated by WO 01/66739 A1 (filing date 12 February, 2001).

According to the USPTO search engine GenCore version 5.1.6, the WO 01/66739 A1, in Claim 7, (Tables 1, 2, and 3) discloses nucleotide sequence that has 99.9% identity to the SEQID NO:1 of the instant invention; and in Claims 16 and 17 discloses vector and host cell for the production of the peptide. In the instant application, Claim 6 (b) refers to 80% identity to the SEQ ID NO:1. (Claims 3, 7, and 8 of the instant invention).

According to the USPTO search engine GenCore version 5.1.6, the WO 01/66739 A1, in Claim 1, (Tables 1, 2, and 3) discloses peptide sequence that has 100% identity to the SEQID NO:2 of the instant invention; and in Claims 16 and 17 discloses vector and host cell for the production of the peptide. (Claims 25-27 of the instant invention).

Conclusion

No Claims are allowed.

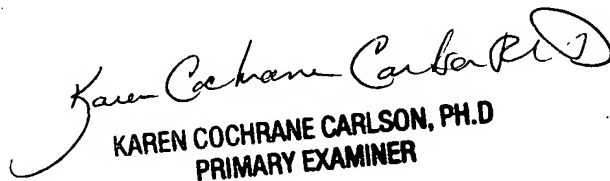
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Agnes Rooke whose telephone number is 571-272-2055. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

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KAREN COCHRANE CARLSON, PH.D
PRIMARY EXAMINER